

21 JAN 2004



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#19

Lawrence S. Perry
Fitzpatrick, Cella, Harper & Scinto
30 Rockefeller Plaza
New York, NY 10112-3801

In re Application of
ICHIMURA, et al.
U.S. Application No.: 09/856,617
PCT No.: PCT/JP99/06487
Int. Filing Date: 19 November 1999
Priority Date: 24 November 1998
Attorney Docket No.: 766.52
For: NOVEL POLYPEPTIDE

DECISION ON PETITION

UNDER 37 CFR 1.181

This decision is in response to applicant's "Request For Decision on Request For Withdrawal of Abandonment" filed 08 January 2004 in the United States Patent and Trademark Office (USPTO). The request referenced a "Request For Withdrawal of Notification of Defective Response Abandonment" filed 20 June 2003. A search of the application file finds the original paper contained therein. The request is being treated as a petition under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 19 November 1999, applicant filed international application PCT/JP99/06487 which claimed priority to a Japanese application filed 24 November 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 02 June 2000. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 24 May 2001.

On 24 May 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a translation of the international application into English; a First Preliminary Amendment; an executed oath or declaration of the inventors

On 07 September 2001, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) and a NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES (Form PCT/DO/EO/920) informing applicant of the need to file a sequence listing for the present application. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 25 September 2001, applicant filed a response including submission of a new sequence listing including computer readable form diskette.

On 02 July 2002, applicant was mailed a "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) informing applicant that the sequence listing filed 25 September 2001 did not comply 37 CFR 1.821-1.825 and thus was not a proper response to the Form PCT/DO/EO/905 mailed 07 September 2001. Applicant was afforded one month from the mailing of the Form PCT/DO/EO/916 or within the time remaining in the response set forth in the Form PCT/DO/EO/905, whichever was longer.

On 05 August 2002, applicant filed a response including submission of a new sequence listing including computer readable form diskette.

On 09 January 2003, applicant was mailed a "NOTIFICATION OF DEFECTIVE RESPONSE ABANDONMENT" (Form PCT/DO/EO/918) informing applicant that the sequence listing filed 05 August 2002 did not comply 37 CFR 1.821-1.825 and thus was not a proper response to the Form PCT/DO/EO/905 mailed 07 September 2001. Applicant was afforded one month from the mailing of the Form PCT/DO/EO/916 or within the time remaining in the response set forth in the Form PCT/DO/EO/905, whichever was longer.

On 22 January 2003, applicant filed a response including submission of a new sequence listing including computer readable form diskette.

On 06 June 2003, applicant was mailed a "NOTIFICATION OF DEFECTIVE RESPONSE ABANDONMENT" (Form PCT/DO/EO/918) informing applicant that the sequence listing filed 22 January 2003 did not comply 37 CFR 1.821-1.825 and thus was not a proper response to the Form PCT/DO/EO/905 mailed 07 September 2001. Applicant was further informed that the application was abandoned as to the National stage in the United States of America.

On 20 June 2003, applicant filed the present petition under 37 CFR 1.181 seeking withdrawal of the holding of abandonment.

On 08 January 2004, applicant filed a request for decision in the present action.

DISCUSSION

Applicant seeks withdrawal of the holding of abandonment in the present application based on the filing of 25 September 2001. However, it appears that applicant has misinterpreted the Form PCT/DO/EO/918 mailed 06 June 2003. The USPTO does not dispute that applicant filed a response on 25 September 2001. This filing was received and resulted in the preparation and mailing of a Form PCT/DO/EO/916 mailed 02 July 2002. In addition, applicant subsequently filed responses on 05 August 2002 and 22 January 2003. However, none of the sequence listings filed to date have been in compliance with 37 CFR 1.821-1.825. As such, while timely, the responses were not proper and the application was therefore held to be abandoned. Enclosed with this decision is a courtesy copy of the most recently

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prepared CRF Problem Report.

CONCLUSION

For the reasons above, applicant's petition under 37 CFR 1.181 is **DISMISSED**.

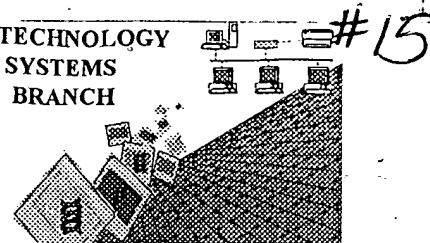
This application remains abandoned as to the United States of America.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: 703-305-0130
Fax: 703-308-6459

Encl: Raw Sequence Listing Error Report



RAW SEQUENCE LISTING ERROR REPORT

The Biotechnology Systems Branch of the Scientific and Technical Information Center (STIC) detected errors when processing the following computer readable form:

Application Serial Number: 09/856,617B
Source: PC1709
Date Processed by STIC: 5/19/2003

THE ATTACHED PRINTOUT EXPLAINS DETECTED ERRORS.

PLEASE FORWARD THIS INFORMATION TO THE APPLICANT BY EITHER:

- 1) INCLUDING A COPY OF THIS PRINTOUT IN YOUR NEXT COMMUNICATION TO THE APPLICANT, WITH A NOTICE TO COMPLY or,
- 2) TELEPHONING APPLICANT AND FAXING A COPY OF THIS PRINTOUT, WITH A NOTICE TO COMPLY

FOR CRF SUBMISSION AND PATENTIN SOFTWARE QUESTIONS, PLEASE CONTACT MARK SPENCER, 703-308-4212.

TO REDUCE ERRORED SEQUENCE LISTINGS, PLEASE USE THE CHECKER VERSION 4.0 PROGRAM, ACCESSIBLE THROUGH THE U.S. PATENT AND TRADEMARK OFFICE WEBSITE. SEE BELOW FOR ADDRESS:

<http://www.uspto.gov/web/offices/pac/checker>

Applicants submitting genetic sequence information electronically on diskette or CD-Rom should be aware that there is a possibility that the disk/CD-Rom may have been affected by treatment given to all incoming mail.

Please consider using alternate methods of submission for the disk/CD-Rom or replacement disk/CD-Rom.

Any reply including a sequence listing in electronic form should NOT be sent to the 20231 zip code address for the United States Patent and Trademark Office, and instead should be sent via the following to the indicated addresses:

1. EFS-Bio (<<http://www.uspto.gov/ebc/efs/downloads/documents.htm>> , EFS Submission User Manual - ePAVE)
2. U.S. Postal Service: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
3. Hand Carry directly to:
U.S. Patent and Trademark Office, Technology Center 1600, Reception Area, 7th Floor, Examiner Name, Sequence Information, Crystal Mall One, 1911 South Clark Street, Arlington, VA 22202
Or
U.S. Patent and Trademark Office, Box Sequence, Customer Window, Lobby, Room 1B03, Crystal Plaza Two, 2011 South Clark Place, Arlington, VA 22202
4. Federal Express, United Parcel Service, or other delivery service to: U.S. Patent and Trademark Office, Box Sequence, Room 1B03-Mailroom, Crystal Plaza Two, 2011 South Clark Place, Arlington, VA 22202

Revised 04/24/2003



OIPE

RAW SEQUENCE LISTING

DATE: 05/19/2003

PATENT APPLICATION: US/09/856,617B

TIME: 15:00:41

Input Set : A:\766.52.txt

Output Set: N:\CRF4\05192003\I856617B.raw

3 <110> APPLICANT: KYOWA HAKKO KOGYO CO., LTD.,
 5 <120> TITLE OF INVENTION: NOVEL POLYPEPTIDE
 7 <130> FILE REFERENCE: 766.52
 9 <140> CURRENT APPLICATION NUMBER: US 09/856,617B
 10 <141> CURRENT FILING DATE: 2001-05-24
 12 <150> PRIOR APPLICATION NUMBER: H10-332484
 13 <151> PRIOR FILING DATE: 1998-11-24
 15 <150> PRIOR APPLICATION NUMBER: H11-248442
 16 <151> PRIOR FILING DATE: 1999-09-02
 18 <160> NUMBER OF SEQ ID NOS: 18
 19 <170> SOFTWARE: PatentIn Ver. 2.0

Does Not Comply
Corrected Diskette Needed

ERRORED SEQUENCES

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 2037 <212> TYPE: DNA
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 2040 <220> FEATURE:
 2041 <221> NAME/KEY: CDS
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 2047 1 5 10 15
 2049 agc cag gcg gac tct ggc ttc ctg ggg ctg cgg ccg acc tcg gtg gat 99
 2050 Ser Gln Ala Asp Ser Gly Phe Leu Gly Leu Arg Pro Thr Ser Val Asp
 2051 20 25 30
 2053 ccc gct ctg agg cgg cgg cgg ggc ccc aga aac aag aag cgc ggc 147
 2054 Pro Ala Leu Arg Arg Arg Arg Arg Gly Pro Arg Asn Lys Lys Arg Gly
 2055 35 40 45
 2057 tgg agg agg ctc gcc gag gag ccg ctg ggg tta gag gtc gac cag ttc 195
 2058 Trp Arg Arg Leu Ala Glu Glu Pro Leu Gly Leu Glu Val Asp Gln Phe
 2059 50 55 60
 2061 ctg gaa gac gtc cgg cta cag gag cgc acg acc ggt ggc ttg ttg gca 243
 2062 Leu Glu Asp Val Arg Leu Gln Glu Arg Thr Thr Gly Gly Leu Leu Ala
 2063 65 70 75
 2065 gag gcc cca aac gaa aag ctc ttc ttc gtg gac aca gga ttc aag aga 291
 2066 Glu Ala Pro Asn Glu Lys Leu Phe Phe Val Asp Thr Gly Phe Lys Arg
 2067 80 85 90 95
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 2070 Lys Glu Pro Arg Lys Lys Arg Thr Leu Val Gln Lys Lys Ser Gln Arg

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2087	160			165			170	175
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2097	ggt	cag	gat	gca	ttt	ttt	ctg	gaa
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2103		225			230			235
2105	gtg	att	cct	gca	gga	gcc	tcc	tac
2106	Val	Ile	Pro	Ala	Gly	Ala	Ser	Tyr
2107	240			245			250	255
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2126	Glu	Ala	Gly	Asp	Gly	Thr	Thr	Glu
2127	320			325			330	335
2129	cct	gag	aag	agg	atg	gag	aag	aag
2130	Pro	Glu	Lys	Arg	Met	Glu	Lys	Lys
2131			340			345		350
2133	aaa	gct	gct	cgc	aag	ctg	cgg	gtg
2134	Lys	Ala	Ala	Arg	Lys	Leu	Arg	Val
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TIME: 15:00:41

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Output Set: N:\CRF4\05192003\I856617B.raw

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2143      385      390      395
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VERIFICATION SUMMARY

DATE: 05/19/2003

PATENT APPLICATION: US/09/856,617B

TIME: 15:00:42

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